

REMARKS

Reconsideration and allowance of the subject application are respectfully requested.

Upon entry of this Amendment, claims 1-3 are pending in the application. In response to the October 21, 2004 Office Action, Applicant respectfully submits that the pending claims define patentable subject matter.

Claim 3 is objected to because the Examiner maintains that the claim language contains grammatical errors. By this Amendment, Applicant has amended claim 3 to improve clarity. Accordingly, the Examiner is requested to remove the objection to claim 3.

Claims 1 and 2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tamai (U.S. Patent Appln. No. 2001/0035297) in view of Shimomura (JP 6-153360). Applicant respectfully traverses the prior art rejection.

With regard to claims 1 and 2, the Examiner cites Tamai (Figure 3a) for disclosing an electric wire including a first conductor which is coated with resin, and a second conductor (11a) at two ends (only one shown) of the coated wire. The Examiner concedes that "Tamai does not disclose the second conductor being of a truncated cone-shaped formed at two end of the coated wire and of which diameter at both end portions is 90% to 50% as large as diameter A nor the winding members being mounted on a stator." However, the Examiner cites Shimomura (Figures 3a-3c) for allegedly disclosing an electric wire (1,2) having truncated cone-shaped at an end portion, and asserts that "it would have been obvious to ... modify the second conductor of Tamai to be a truncated cone-shaped as taught by Shimomura so that the coated wire can be joined to an electrical device having a receptacle with similar shape." The Examiner further

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asserts that “[i]t would also have been obvious to ... mount the winding members (10) of Tamai on a stator since using coated wires in an electric rotating machine (a stator) is known in the art.”

By this Amendment, Applicant has amended claim 1 to recite an electric rotating machine winding comprising a plurality of a plurality of winding members having a curved shape, wherein the winding members are joined at end portions of the second conductors to form a continuous wave winding. In addition, claim 2 has been amended in a manner similar to claim 1 and to positively recite the claimed method steps. Applicant respectfully submits that it is quite clear that neither reference discloses the curved shape of the first conductor, or joining end portions of the second conductors to form a continuous wave winding, as claimed.

With regard to the limitations directed an electric rotating machine, the Examiner cites *In re Casey* and *In re Otto* for holding that

a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

However, as set forth in MPEP 2115, this line of cases is limited to claims directed to machinery which works upon an article or material in its intended use, and does not apply to product claims or kit claims. MPEP 2115. Moreover, there is no teaching or suggestion in the cited references that the disclosed wires are suitable for use in as a stator winding. Tamai indicates that the disclosed electric wire is utilized in electronic instruments and circuit boards

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and Shinomura indicates that the disclosed cable is a power cable, such as a CV cable. Further, the manner in which Shinomura teaches that the cables are connected (see Figs. 1 and 4) is clearly inapplicable to stator windings. Lastly, the steps of claim 2 (assembling and mounting) result in a manipulative difference as compared to the prior art.

In view of the above, Applicant respectfully submits that amended claims 1 and 2 should be allowable because over the cited references, alone or combined, do not teach or suggest all of the features of the claims.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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CUSTOMER NUMBER

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